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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/728,564

12/05/2003

Steve D. Huseth

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(H0006281-0760)

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7590 04/17/2007  
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EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT

PAPER NUMBER

2612

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/728,564

Applicant(s)

HUSETH ET AL.

Examiner

Brian A. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2007 and 01 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-16,18-21 and 23-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-16,18-21 and 23-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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***Status of Application***

In response to the applicant's amendment received on 2/11/07 and 3/1/07. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-7,9-16,18-21,23-53 are unpatentable for the reasons set forth in this office action:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 37,39,44,47,52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 37, support has not been pointed out by the applicant, nor could support be easily found in the specification, for the new limitation that a single device contains both a fob and a badge.

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Regarding claims, 39 and 47, support has not been pointed out by the applicant, nor could support be easily found in the specification, for the new limitation of authorizing access to information.

Regarding claims, 44 and 52, support has not been pointed out by the applicant, nor could support be easily found in the specification, for the new limitation of a card reader.

2. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 depends on cancelled claim 17. For consideration of art rejections below, it is considered that claim 25 depends on claim 14.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

3. Claims 26-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Berardi (2003/0167207).

Berardi shows a method for providing access to a financial transaction, where the system includes two versions of the transponder 102. The first embodiment of transponder 102 does not include a fingerprint reader (figure 2); this is interpreted as a

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badge. The second embodiment of transponder 102 includes a fingerprint reader (figure 9); this is interpreted as a keyfob. The figure 9 transponder sends the fob ID (stored in memory 214) with the fingerprint so both can be authenticated. When the data is read from the transponder, a comparison is made to authorize financial access; this meets the limitation of determining if the received code is authentic and providing access upon authentication. If the data is from a badge, the authorization step compares account data (or the transponder ID), paragraph 59. If the data is from a keyfob the authorization step compares fingerprint data, paragraph 141. It is the examiner's position that in order to compare the received data from the figure 9 transponder with stored fingerprint data, a decision inherently is made that the data received includes fingerprint data. This meets the limitation of determining if the code is from a badge or keyfob.

4. Claims 38-41,45-49,53 are rejected under 35 U.S.C. 102(e) as being anticipated by Fitzgibbon (2003/0210131).

Fitzgibbon teaches an access security system where a transmitter can send codes to a garage door for access authorization. The portable transmitter (authorization module) can additionally include a fingerprint reader to send information regarding the user's fingerprint, also for authorization. Fitzgibbon includes a processor (figure 4) in communication with the transmitters to process data received and make an authorization determination, see figure 8. A gate lock is considered a door lock. Fitzgibbon is cited for teaching that in this type of system, the use of rolling codes can

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improve the security of the system. See figure 5. Fitzgibbon incorporates by reference US Pat 5949349 and states that the system disclosed can be used to open the gates as described in US Pat 5949349. US Pat 5949349 discuss a plurality of authorization modules associated with a gate to allow entry into the facility See abstract of 5949349. Therefore using Fitzgibbon's authorization in a plural transmitter gate or garage door opening system is taught and shown by Fitzgibbon. Paragraph 52 of Fitzgibbon discusses learning a rolling code and storing in an associated table via an address of the table, looking up in the code table is considered a shared and indexed mathematical function as claimed.

***Claim Rejections - 35 USC § 103***

5. Claims 1-7,9-16,18-21,23-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Berardi in view of Fitzgibbon.

Berardi shows a method for providing access to a financial transaction, where the system includes two versions of the transponder 102. The first embodiment of transponder 102 does not include a fingerprint reader (figure 2); this is interpreted as a badge. The second embodiment of transponder 102 includes a fingerprint reader (figure 9); this is interpreted as a keyfob. The figure 9 transponder sends the fob ID (stored in memory 214) with the fingerprint so both can be authenticated. When the data is read from the transponder, a comparison is made to authorize financial access; this meets the limitation of determining if the received code is authentic and providing access upon authentication. If the data is from a badge, the authorization step

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compares account data (or the transponder ID), paragraph 59. If the data is from a keyfob the authorization step compares fingerprint data, paragraph 141. It is the examiner's position that in order to compare the received data from the figure 9 transponder with stored fingerprint data, a decision inherently is made that the data received includes fingerprint data. This meets the limitation of determining if the code is from a badge or keyfob.

In an analogous art, Fitzgibbon teaches an access security system where a transmitter can send codes to a garage door for access authorization. The portable transmitter (authorization module) can additionally include a fingerprint reader to send information regarding the user's fingerprint, also for authorization. Fitzgibbon includes a processor (figure 4) in communication with the transmitters to process data received and make an authorization determination, see figure 8. Fitzgibbon is cited for teaching that in this type of system, the use of rolling codes can improve the security of the system. The fingerprints and rolling codes are separately checked against databases for authenticity. See figure 8.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the fingerprint and rolling code processing of Fitzgibbon in the fingerprint entry transponder embodiment of Berardi because adding rolling code authentication increases security in the system.

6. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berardi as applied to claim 32 above, and further in view of Fitzgibbon.

In an analogous art, Fitzgibbon teaches an access security system where a transmitter can send codes to a garage door for access authorization. The portable transmitter (authorization module) can additionally include a fingerprint reader to send information regarding the user's fingerprint, also for authorization. Fitzgibbon includes a processor (figure 4) in communication with the transmitters to process data received and make an authorization determination, see figure 8. Fitzgibbon is cited for teaching that in this type of system, the use of rolling codes can improve the security of the system. The fingerprints and rolling codes are separately checked against databases for authenticity. See figure 8.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the fingerprint and rolling code processing of Fitzgibbon in the fingerprint entry transponder embodiment of Berardi because adding rolling code authentication increases security in the system.

7. Claims 42-44, 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzgibbon as applied to claims 38 and 46 above, and further in view of Berardi.

Berardi shows an access control system including a transponder, which may be embodied in a fob, tag, card, see paragraph 21. The figure 9 transponder sends the fob ID (stored in memory 214) with the fingerprint so both can be authenticated, thereby suggesting a fingerprint fob.

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Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have formed the Fitzgibbon controller into a key fob or a card since Berardi suggests these embodiments for an access device and such physical embodiments are recognized in the art as easily portable.

### ***Response to Arguments***

Applicant's arguments filed 2/11/07 have been fully considered but they are not persuasive.

The applicant argues the 102 rejections of 1,2,7,13,14 by pointing to new claim limitations that were not previously present in these claims. The new rejections include a previously cited (and used) Fitzgibbon reference. The applicant argues against The Berardi/Fitzgibbon combination by stating there is no motivation to combine. As pointed out above, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the fingerprint and rolling code processing of Fitzgibbon in the fingerprint entry transponder embodiment of Berardi because adding rolling code authentication increases security in the system. Additionally it is pointed out that motivation for the Fitzgibbon/Berardi combination (for claims 42-44,50-52) properly includes motivation, see above rejection.

The applicant additionally argues against the Berardi/Fitzgibbon combination by stating there is no expectation of success from the combination. It remains the examiner's position that predictably using the fingerprint and rolling code of Fitzgibbon

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would provide increase security for Berardi since Berardi suggest using fingerprint data to increase security.

The applicant additionally argues against the Berardi/Fitzgibbon combination by stating the examiner has not identified each and every claim limitation. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention *without specifically pointing out how the language of the claims patentably distinguishes them from the references.*

Merely copying a claim and saying the reference does not show claim 3, is not specifically pointing out how the language of the claims patentably distinguishes them from the references.

The applicant has presented new claims 38-53. The applicant has not pointed out support in the original specification, nor has the applicant pointed out specifics of the claims that patentably distinguish them from the references. 37 CFR 1.111 (b and c).

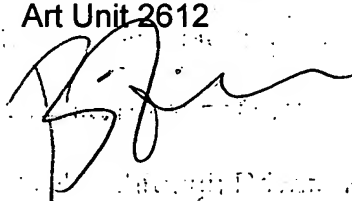
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A. Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on 7 am to 4 pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 571-272-7308. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian A Zimmerman  
Primary Examiner  
Art Unit 2612



BZ